

REMARKS

At the outset, Applicants wish to thank Examiner Do for the courtesies extended to Applicants' representatives during the December 17, 2004 telephone interview. The substance of the interview is incorporated in the following remarks.

Summary of the Office Action

Claims 1 and 10-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP 10157150 to *Sato*.

Claim 13 is rejected under 35 U.S.C. § 102(b) as being unpatentable over *Sato* in view of U.S. Patent No. 5,458,254 to *Miyagawa*.

Summary of the Response to the Office Action

Applicants amend independent claims 1, 12, and 13 to further clarify the invention. Claims 2-9 are withdrawn from consideration. Accordingly, claims 1 and 10-13 are pending for further consideration.

All Subject Matter Complies With 35 U.S.C. § 102(b)

Claims 1 and 10-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Sato*. Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) is traversed for the following reasons.

Sato shows a method for manufacturing a ink jet recording head. *Sato*'s focus is to manufacture an ink jet recording head that has a flat orifice plate that reproduces stable small ink droplets. See the English language translation of the Abstract of *Sato*. However, *Sato* is cited within the present specification at page 2, lines 1-5 as background art, and the Applicants have distinguished the present invention from it.

Applicants respectfully submit that *Sato* does not disclose at least the “material of the resinous base is the same as that of the resin body, and the resinous base supports at least a portion of the resin body,” as recited in newly amended independent claims 1, 10, and 11. In the present invention, the resin body defining the ink chamber discharge section and the ink chamber, can be flatly formed without removing the resinous base during manufacture of the ink jet recording head. Because the resinous base and the resin body are made from the same material, there is no difference in their coefficients of thermal expansion. See page 4, lines 2-14 of the specification.

Further, because the resinous base does not need to be removed, (wherein *Sato* the resinous base is removed to create (8) a hole parallel to the ink channel, (unlabeled)) the problems associated with ink eroding the adhesion between the substrate and resin body are not realized. See page 4, lines of the specification. This problem can cause ink pooling, or dust, and the degradation of the ink jet recording head performance. See page 4, lines 2-14 of the specification.

Sato does not act to restrict the “cracking caused by a difference between coefficients of thermal expansions of the substrate 12 and the resin having photo-sensitivity 42 (and the base 16),” as stated in the specification at page 14, lines 17-22. Moreover, *Sato* does not even identify the problem of “cracking” due to differing coefficients of thermal expansion and embedding “a resinous base” as a way to mitigate such cracking. In fact, *Sato* does not discuss the recited features that address the above-mentioned problem at all. As such, *Sato* cannot anticipate the present invention.

As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. Of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Sato* does not teach or suggest each feature of newly amended independent claims 1, 10, and 11. Additionally, claims 12 and 13 which depend from independent claim 1, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sato* in view of *Miyagawa*. Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) is traversed for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action fails to meet the criteria to establish a prima facie case of obviousness. In particular, neither *Sato* nor *Miyagawa*, either alone or in combination teach or suggest at least the features “material of the resinous base is the same as that of the resin body, and the resinous base supports at least a portion of the resin body,” as recited in newly amended independent

claim 1. Thus, the cited references fail to teach or suggest all claim limitations of dependent claim 13.

Moreover, as previously proven by the removal of *Miyagawa* as a 102(b) reference, *Miyagawa* does not make up for the deficiencies of *Sato* and, therefore, cannot make obvious the present invention. Thus, the Office Action fails to establish a *prima facie* case of obviousness at least because it does not teach all the recited claim features. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn because neither *Sato* nor *Miyagawa*, teaches or suggests each feature of claim 13.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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